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| APPLICATION NO.                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/696,739                       | 10/28/2003  | Rex Miller           | 0275M-000650        | 6312             |
| 27572                            | 7590        | 07/01/2008           |                     |                  |
| HARNESS, DICKEY & PIERCE, P.L.C. |             |                      |                     |                  |
| P.O. BOX 828                     |             |                      |                     |                  |
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| SAUTHER, FLEMING                 |             |                      |                     |                  |
| ART UNIT                         |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/696,739

**Applicant(s)**

MILLER ET AL.

**Examiner**

Flemming Saether

**Art Unit**

3677

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-10, 13, 15-17, 19, 20, 22-24, 27-30, 32-34, 38-42, 44-46 and 48-54 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9, 13, 20, 23, 42 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 10, 12, 15-17, 19, 22, 24, 27-30, 32-34, 38-41, 44-46, 49-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Election/Restriction***

Claims 8, 9, 13, 20, 23, 42, and 48 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) in view of election in the paper filed 2-24-2005.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 6, 7, 10, 12, 15-17, 19, 22, 24, 27-30, 32-34, 38-41, 44-46, and 49-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutter (US 5,704,747) in view of Peterson (US 5,096,350). As best seen in Fig.8, Hutter discloses fastener assembly including a nut (18) wherein the nut is shown to have a transition portion including a conical countersink and concave radius interface with a thickness greater than that of both a threaded cylindrical body and transverse base and spanning substantially the entire transition portion. Hutter further discloses the nut received within a retaining means (20) having a planar surface which allows the nut limited movement relative thereto. The fastener assembly is described as intended for use with automobile (column 1, line 17). The formation of the body by heat treating or cold working is a product-by-process limitation wherein it is only the final product considered for patentability. Hutter does not disclose the configuration of the retaining means as formed pair of bent over flanges including open ends. Peterson discloses a similar type fastener assembly as Hutter but, Peterson discloses the retaining means formed as pair of flanges (34, 36) bent over to cover a nut base portion (see Fig. 2) and configured to

include open ends. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the retaining means of Hutter with one as disclosed in Peterson because the retaining means disclosed in Peterson is of a simplified structure and Hutter does not have any criticality to the dome shaped retaining means and. The cage as disclosed in Peterson is only a single piece whereas the Hutter is two separate pieces. Lastly, the specific material and its strength properties would have been recognized depending upon the particular application of the assembly.

Since Hutter shows the shape of the countersink shape to be the same as that disclosed, it also inherently includes the "flat surface".

In regards to claim 3, the welding of a cage nut is well known and would have been recognized as a substitute for the adhesive of Hutter depending upon the particular application. In other words, the skilled artisan would have recognized to weld the cage onto the substrate if the substrate were metal rather than composite. There is nothing which would preclude the cage from being welded onto a metal substrate.

In regards to claims 24, 49 and 54, in order to satisfy the requirement that the outer diameter of the conical portion is greater than the first diameter (presuming the first diameter is intended to be that of the nut body) the first diameter is read as the inner diameter of the nut thus making the conical portion's diameter greater in relation thereto. Alternatively, it would have been obvious to change the size of the conical portion in Hutter to be within the relative range as claimed since changing dimensions is well known to yield predictable results such as in this case, a simply larger conical

portion which in this case would have the added benefit of aligning the fastener over a greater range.

### ***Response to Remarks***

The rejections under section 112 have been withdrawn. However, the rejection under section 103 has been maintained unchanged.

Applicant's Declaration is not a convincing showing to commercial success for two reasons. First, it has not been shown that the fasteners are commercially successful. What makes 6% or even 16% commercially successful? Seems the fastener occupying the other 84% of the market would be more successful. With regards to higher price it has not been shown that it is the claimed features which warrant the higher price. There are other factors which would affect the pricing such as availability, promotions and even the buyers' knowledge of the competitors' products. Second, it has not been shown that it is features of the claims alone which are the cause of the commercial success. The discussion with the buyers that reason their reason for purchasing the fasteners is the "technical merit" does not show that the technical merit is solely what is the subject of the claims. There may be other features of the invention which influence the "technical merit" for example, the quality of the materials used or the quality of manufacturing. Generally, applicant had not shown that there is a feature or combination of features in each of the claims which is the cause of the commercial success. Indeed this application includes numerous claims directed to

different technical aspects of the invention. The "technical merit, for example, due to essentially the mechanical features noted in the attached claims" is simply too broad since it does not point to any feature or combination the features which is included in each of the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Flemming Saether  
Primary Examiner  
Art Unit 3677

/Flemming Saether/  
Primary Examiner, Art Unit 3677